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MAY 20 2009

OFFICE OF PETITIONS

In re Application of  
Nishida et al.  
Application No. 08/295686  
Filing or 371(c) Date: 08/24/1994  
Attorney Docket Number: 52433354

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DECISION  
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ON PETITION  
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This is a decision on the "Request for Reconsideration of Petition Under 37 C.F.R. § 1.137(a) and Request for Reconsideration of Petition Under 37 C.F.R. § 1.181," filed February 24, 2009, to revive the above-identified application, or to withdraw the holding of abandonment respectively.

The Petition under 37 CFR 1.137(a) is hereby **granted**.

The Petition under 37 CFR 1.181(a) is hereby **dismissed**.

**Background**

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed March 24, 1995. The Office action set a extendable three (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No complete and proper reply having been received, the application became abandoned on June 25, 1995. A Notice of Abandonment was mailed October 17, 1995.

**The petition (originally filed August 22, 2008 (Certificate of Mailing dated November 7, 1995))**

Applicant files the present petition, and asserts that timely reply to the Office action, including a request for a three (3) month extension of time and fee, were filed on September 22, 1995 (Certificate of Mailing dated September 20, 1995). In support of this assertion, Applicant files a copy of the reply, and a copy of Applicant's return-receipt postcard acknowledging receipt by this Office of a Response and an Extension Request on September 22, 1995. A review of the copy of the reply filed with the petition reveals that the reply contains a Certificate of Mailing under 37 CFR 1.8 dated September 20, 1995, and executed by Petitioner herein.

Office records do not indicate receipt of the reply on or about September 22, 1995, or the petition on or about November 7, 1995. Office records do, however, reveal that the fee for a three (3) month extension of time was received in this Office on September 22, 1995, and the fee for a petition to revive an application abandoned unavoidably was received in this Office on November 9, 1995.

The petition was dismissed in a Decision mailed September 22, 2008, because Applicant had failed to demonstrate diligence in prosecuting the application. The Decision dismissing the petition stated that the delay in prosecuting the application in this instance is more than 12 years, and the burden of continuing the process of presenting a grantable petition in a timely manner remains with the applicant until the applicant is informed that the petition is granted. See In re Application of Takao, 17 USPQ2d 1155, at 1158 (Comm'r Pat. 1990). The Decision noted that Applicant has the duty to make sure his application is being prosecuted. Winkler v. Ladd, 221 F. Supp. 550, 552 (D.D.C. 1962). Moreover, diligence on the part of the applicant is essential to show unavoidable delay. See, Future Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431 (E.D. Va. 1988). Diligent inquiry into the status of the application is required. Id.

#### **The November 21, 2008 petitions requesting reconsideration**

Applicant filed a Request for Reconsideration of Petition Under 37 C.F.R. § 1.137(a) and attempted to differentiate the case law from the facts of the present case, and stated that in the present case, Applicant timely and diligently filed the petition, including the requisite extension of time, and it is this Office that failed to timely act on the petition. The petition ignores Petitioner's duty to make sure his application is being prosecuted. Petitioner has not provided any explanation as to why more than 12 years passed without any action on the part of Petitioner to make sure that his application was being processed.

The petition was dismissed in a Decision mailed December 12, 2008. The Decision dismissing the petition noted that since the above-identified application was filed before June 8, 1995, 37 CFR 1.137(d) requires a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted on the application or any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application.

Petitioner also filed a Request for Reconsideration of Petition Under 37 CFR 1.181 and asserted that the petition was being filed in response to the Decision on Petition mailed September 22, 2008, but also petitions "to withdraw the holding of abandonment of the above-identified application by the Notice of Abandonment mailed October 17, 1995."

The petition was also dismissed in a Decision mailed December 12, 2008. The Decision noted that the petition was filed to withdraw the holding of abandonment of the above-identified application by the Notice of Abandonment mailed October 17, 1995. The petition, filed more than 13 years after the mailing of the Notice of Abandonment, was dismissed as untimely.

**The present petitions requesting reconsideration**

Petitioner files the present request for reconsideration under 37 CFR 1.137(a), and includes a terminal disclaimer and fee.

The petition satisfies the requirements of 37 CFR 1.137(a) in that petitioner has supplied (1) the required reply in the form of the request for reconsideration of the Office action mailed March 24, 1995; (2) the petition fee; and (3) a showing to the satisfaction of the Director that the entire delay was unavoidable, and (4) a terminal disclaimer and fee as required by 37 CFR 1.137(d). Accordingly, the reply may be accepted as being unavoidably delayed.

The terminal disclaimer is accepted and has been made of record. Any continuing application filed from this application must contain a copy of the terminal disclaimer. The copy of the terminal disclaimer must be filed with a cover letter requesting the terminal disclaimer be recorded on the continuing application. A copy of this decision should be attached to the cover letter.

Petitioner also files a Request for Reconsideration of Petition Under 37 CFR 1.181 wherein Petitioner avers that the "action or notice from which relief was requested by the Petition Under 37 C.F.R. 1.181," was the Decision on Petition mailed September 22, 2008. As noted previously, Petitioner petitions "to withdraw the holding of abandonment of the above-identified application by the Notice of Abandonment mailed October 17, 1995." The Decision mailed September 22, 2008, did not hold the application abandoned. Applicant was informed of the abandonment of the application by the mailing of the Notice of Abandonment on October 17, 2005. In response to the Notice of Abandonment, Applicant filed a petition to revive the application under 37 CFR 1.137(a) on November 7, 1995. Thereafter, a Decision on the petition was mailed September 22, 2008, and Petitioner for the first time filed a petition to withdraw the holding of abandonment on December 24, 2008. Petitioner did not petition to withdraw the Decision on Petition mailed September 22, 2008. The action or notice from which relief was requested was the holding of abandonment, which Petitioner was informed of with the mailing of the Notice of Abandonment on October 17, 2005.

37 CFR 1.181(f) states in relevant part that "[a]ny petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable." As noted supra, the petition, filed more than 13 years after the mailing of the Notice of Abandonment, is dismissed as untimely.

The application will be referred to Group Art Unit 1794 for consideration of the reply submitted with the original petition for revival.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/  
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